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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/622,001	09/22/2000	Yasutaka Ishii	3273-0121P	5966

2292 7590 01/24/2002

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EXAMINER

SOLOLA, TAOFIQ A

ART UNIT	PAPER NUMBER
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1626

DATE MAILED: 01/24/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/622,001

Applicant(s)

Ishii et al.

Examiner

Taofiq A. Solola

Art Unit

1626



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE one MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claims 1-21 are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- a) ☐ All b) ☐ Some\* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

### Attachment(s)

- 15) ☐ Notice of References Cited (PTO-892)
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_
- 18) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 19) ☐ Notice of Informal Patent Application (PTO-152)
- 20) ☐ Other:

Art Unit: 1626

## DETAILED ACTION

### *Election/Restrictions*

Restriction is required under 35 U.S.C. 121 and 372.

This application contains the following inventions or groups of inventions which are not so linked as to form a single general inventive concept under PCT Rule 13.1.

In accordance with 37 CFR 1.499, applicant is required, in response to this action, to elect a single invention to which the claims must be restricted.

Group I, claim(s) 1-2, 21, process of making organic compounds of no specific structure, not classifiable. *1-3, 14-21*

Group II, claim(s) 3, 21, process of making alpha-hydroxy-butyrolactone, classifiable in class 549, subclass 295+.

Group III, claim(s) 4, second process of making alpha-hydroxy-butyrolactone, classifiable in class 549, subclass 295+.

Group IV, claim(s) 5, compounds of formulae 6b, classifiable class 549, subclass 264+.

Group VI, claim(s) 6, compounds of formulae 6c, classifiable class 549, subclass 294+.

Group VII, claim(s) 7, compounds of formulae 6d, classifiable classes 549, 568, subclass 313+.

Group VIII, claim(s) 8, compounds of formulae 8, classifiable classes 549, 560 subclass 183, 314, 317+.

Art Unit: 1626

Group IX, claim(s) 9-10, polymer of compound 9, classifiable class 521.

Group X, claim(s) 11-13, compounds of formulae 10, classifiable class 549, subclass 263+.

Group XI, claim(s) 14, 21, unsaturated compounds of no specific structure, not classifiable.

Group XII, claim(s) 15, 21, second process of making organic compounds of no specific structure, not classifiable.

Group XIII, claim(s) 16, 21, third process of making organic compounds of no specific structure, not classifiable.

Group XIV, claim(s) 17, 21, fourth process of making organic compounds of no specific structure, not classifiable.

Group XV, claim(s) 18, 21, process of making electron attracting group of no specific structure, not classifiable.

Group XVI, claim(s) 19 21, fifth process of making organic compounds of no specific structure, not classifiable.

Group XVII, claim(s) 20, 21, sixth process of making organic compounds of no specific structure, not classifiable.

The inventions listed as Groups I-III, XI-XVII, do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical feature for the following reasons: there is no corresponding

Art Unit: 1626

technical feature common among the groups. The processes are for making different compounds each having different reagents.

The inventions listed as Groups IV-X, do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical feature for the following reasons: the corresponding technical feature among the groups is alpha-hydroxy-butyrolactone. However, alpha-hydroxy-butyrolactone is well known in the art. Therefore, alpha-hydroxy-butyrolactone does not constitute a special technical feature under PCT Rule 13.1 and 13.2.

A telephone call was made to Rick Gallagager on 1/7/02 to request an oral election to the above restriction requirement, but did not result in an election being made.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(I).

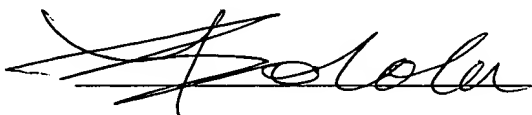
Art Unit: 1626

***Telephone Inquiry***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dr. Taofiq A. Solola whose telephone number is (703) 308-4690. The examiner is on flexible work schedule and the best days to get him are Mondays, Wednesdays and Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Joseph McKane, can be reached on (703) 308-4537. The fax phone number for this Group is (703) 308-4556.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-1235.

A handwritten signature in black ink, appearing to read 'Taofiq A. Solola', with a horizontal line drawn through the middle of the signature.

Taofiq A. Solola, Ph.D.

Primary Examiner

Group 1626

January 21, 2002